

Serial No.: 09/685,138
Docket No.: 112-1001
Amendment Filed with RCE dated April 16, 2008

REMARKS

Introduction

Upon entry of the foregoing amendment, claims 1, 2, 4-8, 22-28 and 31-46 are pending in the application. Claims 1, 4, 7, 8, 22-28, 31-33, 37, 39, and 40 have been amended, and claim 21 has been cancelled by this Amendment. Claims 43-46 have been added. No new matter is being presented. In view of the following remarks, reconsideration and allowance of all the pending claims are requested.

Rejection under 35 USC §112

Claims 41-42 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner contends that the recitation in claim 38 of, "the cover has an overall interior opening of a thickness greater than the overall thickness of the flat ledge," cannot enable, "the thickness of the retractable cover equals the overall thickness of the housing minus the overall thickness of the flat ledge."

Claim 38 recites interior dimensions of the connector cover, while claims 41-42 recite exterior dimensions of the connector cover. As these recitations are accurate, Applicant cannot determine where the Examiner's concerns lie. If, for example, the Examiner cannot resolve the definition of the word "thickness," as used in both the specification and the recitations of the subject claims, such should be articulated. If, on the other hand, the Examiner is concerned with mathematics of the recited subtraction of component dimensions, then such should also be articulated. As the claims now stand, Applicant believes that the recitations of claims 41 and 42 are fully supported by the specification using the terms defined therein and properly depend from claim 38. Accordingly, amendments to the claims do not appear necessary to Applicant, and further clarification cannot be made until the Examiner's concerns have been unambiguously expressed.

Evidence of Non-obviousness

Throughout the prosecution of the subject patent application, Applicant has held firm in its position that Examiner has not, "...cast the mind back to the time the invention was made

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(often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Applicant has maintained that, rather than casting the mind back to the time the invention was made, the Examiner is relying on hindsight to reconstruct Applicant's invention once in possession of the disclosure thereof. Applicant has stated that a cover for an electrical connector, regardless of how long such cover has been known in the electrical connector art, would not have been applicable to a USB portable memory device that can be carried in ones pocket or on a key chain. Applicant respectfully submits the following evidence that Applicant's cover would not have been obvious at the time the present invention was made.

The subject patent application was filed on October 11, 2000, and Applicant's date of invention is at least as early as October 11, 1999, the foreign priority date of Korean Application 43872/1999. As is known in the USB portable memory art, Applicant's date of invention, and even the US filing date of the application thereon, coincides with the infancy of the subject technology itself. As is also well known in the art, and is demonstrated by the prior art of record, covering the USB connector on portable memory devices was largely ignored at the time of Applicant's invention. Applicant's invention proceeded against conventional wisdom of the time, by devoting apparatus complexity and manufacturing cost to cover the USB connector in a non-removable fashion so as to protect the connector while being carried on one's person, such as in a pocket or on a key chain. It is to be noted that the current state of the art is now replete with various solutions to the same problem for which Applicant had the foresight to remedy when the USB portable memory art was in its infancy. For example, US Patent 7,104,814 to She, et al., FIGS. 2A and 2B of which are depicted below in Figure 1, and US Patent 6,808,400 to Tu, FIGS. 2A and 2B of which are depicted below in Figure 2, operate on almost identical principles as Applicant's invention, but the applications from which the illustrative patents issued were filed years later than Applicant's US filing date. In some cases, such as in the She, et al. reference, the application was filed well after a Notice of Allowance was issued in the subject patent application.

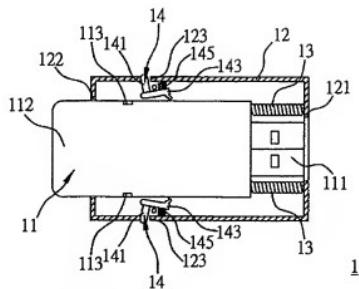


FIG. 2A

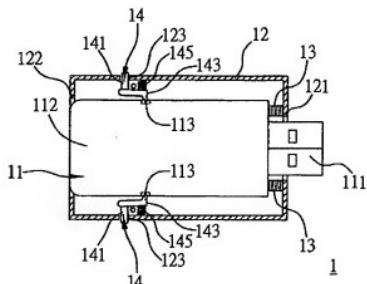


FIG. 2B

Figure 1 – US Patent 7,104,814

It is to be understood that the foregoing are merely examples of a wide range of connector covering solutions for portable memory devices found in the art as classified, for example, in US Patent Classification 439/131 and 439/141. It is also to be understood that Applicant's invention was the first to implement a non-removable covering solution of any type for a USB portable memory device, where numerous mechanisms for such now densely populate the current state of the art.

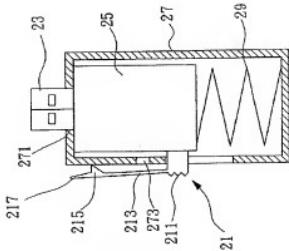


FIG. 2B

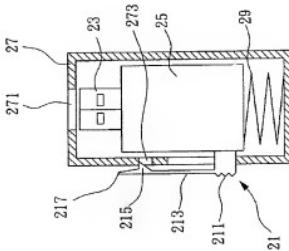


FIG. 2A

Figure 2 – US Patent 6,808,400

Thus, regardless of the state of the power connector art at the time the subject invention was made, Applicant devised an innovative solution to a problem not found elsewhere in the USB portable memory art at that time, namely preventing damage caused by transportation of the connector on one's person, such as in a pocket or on a key-ring.

Rejections under 35 USC §103

- I. Claims 1-2, 4-8, 21-24 have been rejected under 35 U.S.C. §103(a) as being unpatentable over MacHASP USB-Software Protection via the USB by Aladdin Knowledge System published October 1998 (hereinafter "MacHASP") in view of Chinese Publication No. CN2032364U to Liu (hereinafter "Liu"), and further in view of U.S. Patent No. 6,148,354 to Ban

et al. (hereinafter "Ban"). For at least the reasons set forth below, Applicant respectfully traverses the rejections of these claims.

Claim 1

As has already been made of record, Applicant objects to the Examiner's improper reliance on the abstract of Liu. As previously stated during the prosecution of the subject patent application, the Examiner cites features of Liu extracted from some unspecified source in the reference, but which are clearly not gleaned from the Abstract, the only English portion of the reference, and the drawings. Nowhere in either the Abstract or the drawings is there an indication that a sliding cover even exists in Liu's electrical plug. There is certainly no disclosure in the Abstract of such sliding capability of the cover, and the drawings appear to show rigidity in the regions where sliding members would be necessary to enable the cover in Liu to slide in a manner consistent with the recitations of the subject claim. Being that there is no clear teaching by Liu of a sliding cover on the electrical plug therein, the Examiner's application of Liu can only be made through hindsight, i.e. extrapolating unqualified elements of Liu so as to fit the recitations of claim 1, as well as other pending claims of the subject patent application.

As Applicant has previously argued, there are many features of Liu's plug that appear to be unsuited for an application consistent with the recitations of independent claim 1. In fact, there appears to be explicit teaching away from the structural arrangement recited in claim 1 by Liu, however the totality of Liu's teachings cannot be ascertained since the full disclosure thereof is not in English. For example, it cannot be established if the shape of Liu's plug is necessary to its "being a sealed structure that is contacted in different sections at several times," (see Liu Abstract) or which portion of the plug moves, or does not move, to ensure that the "switch [is integrated in the plug] such that it is convenient for use," (see Liu Abstract). Applicant cannot say with certainty what capabilities the connector of Liu has, and neither can the Examiner without a translation of the reference.

As stated in the M.P.E.P §706.02 (II):

Prior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language. When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not

additional facts that may be contained in the underlying full text document. Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished). To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection. An abstract can have a different effective publication date than the full text document. Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency. When both the abstract and the underlying document qualify as prior art, the underlying document should normally be used to support a rejection. In limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action. Whether the next Office action may be made final is governed by MPEP § 706.07(a) (emphases added).

Thus, for at least the reason that Liu fails to properly disclose or teach "a connector cover elastically biased to cover the USB connector when the portable memory device is not connected to the USB-supporting data processing system thereby protecting the USB connector from damage, the connector cover being slidably retractable against the elastic bias to expose the USB connector to be connected to the USB port," as presently recited in independent claim 1, the reference cannot overcome the Examiner's admitted deficiencies of MachASP and Ban. As such, the references, separately or in combination, fail to disclose, teach or suggest all of the elements of the subject claim, and, for at least this reason, cannot make obvious this claim.

For at least the reasons discussed above, withdrawal of the rejections and allowance of the claim 1 are earnestly solicited.

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Claims 2, 4-8, and 22-24

Dependent claims 2, 4-8, and 22-24 incorporate all of the elements and limitations of independent claim 1, and, for at least the reason that MacHASP, Ban, and Liu, separately and in combination, do not disclose, teach or suggest all of the elements of independent claim 1, dependent claims 2, 4-8, and 22-24 are patentably distinguishable over the references. Accordingly, withdrawal of the rejections and allowance of the subject claims are earnestly solicited.

II. Claims 25-28, 31-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,038,320 to Miller (hereinafter "Miller") in view of U.S. Patent No. 6,292,890 to Crisan (hereinafter "Crisan") and further in view of Liu. Applicant respectfully traverses the rejections for at least the reasons discussed below.

Claim 25

The Examiner contends that Miller discloses "determining if a USB device 40 is connected to the computer (110), (if security is enabled) ... and enable the hard disk drive (after the password entered by the user is verified)...". The Examiner is thus adding qualifiers to the recitations of claim 25 so as to fit Miller thereto, but in the process is disregarding the recitations of the subject claim that do not allow such a fit. For example, the Examiner has failed to address how Miller discloses, teaches or suggests, "booting up the host computer only when the USB security device is attached to the USB port of the host and only when the password stored in the USB security device matches the password stored in the host computer" (emphases added), as recited in independent claim 25. Miller nowhere discloses such a protective feature and, in fact, teaches away from such. For example, if a computer operates in accordance with Miller's teachings, and that computer does not have a USB, thereby precluding an ability to "boot[] up the host computer only when the USB security device is attached," the computer in Miller is allowed to boot normally. See Miller, column 4, lines 37-38 and FIG. 6. Thus, it is respectfully submitted that for at least the reason that Miller, and the other references cited, fails to disclose "booting up the host computer only when the USB security device is attached", the reference, alone and in combination with the other references cited, cannot make obvious the subject claim.

In paragraph 10 of the Official Action, the Examiner states, "[p]lease note that

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connecting a device prior to power up, booting the host comprising loading an operating system are inherent during the power up and booting of the computer," and, "[p]lease further note that the claim does not exclude the presence of the step of checking for the enablement of the security and matching of user's password." These statements are further evidence that the Examiner is attempting to make the reference fit to the claim recitations, which is improper. Notwithstanding the Examiner's assertions that the claim recitations do not preclude "checking for the enablement of the security," the fact that the claim recites "booting up the host computer only when the USB security device is attached to the USB port of the host and only when the password stored in the USB security device matches the password stored in the host computer," renders such checking superfluous. The Examiner's further allegation that plugging in a device prior to power up is an inherent feature is immaterial when such plugging in is a feature recited in independent claim 25 to bring about other operations recited therein, but that are not disclosed, taught or suggested in Miller.

The Examiner admits that Miller does not teach "displaying an error message when it is determined that the USB security device is not attached to the USB port of the host" as recited in the subject claim and relies on Crisan as allegedly teaching "that it is common for error to be displayed for error encountered during the boot up process." See page 7 of the Detailed Action, first paragraph. Regardless of whether the Examiner's allegations are based in fact, an error message displayed upon a boot-up error does not equate to "displaying an error message when it is determined that the USB security device is not attached to the USB port of the host", since such is not a "common" determination of a typical system. Indeed, there is no disclosure whatsoever in Crisan directed to determining the presence of a USB security device. But, the fact remains that Crisan fails to overcome the deficiencies of Miller with respect to independent claim 25 and thus cannot make obvious independent claim 25, even when combined with Miller.

The Examiner relies on Liu as allegedly teaching "automatically sliding a cover on said USB security device backward in a direction opposite to a direction of inserting the USB security device into the USB port when the USB security device is attached to the USB port of the host computer," as recited in claim 25. But, for at least the reasons discussed above with regard to claim 1, Liu fails to disclose such a sliding cover. Liu also fails to overcome the deficiencies of Miller and Crisan, and for at least the reason that Miller, Crisan and Liu, separately and in combination, fail to disclose, teach or suggest the full recitations of independent claim 25, the

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references cannot make obvious independent claim 25. Accordingly, withdrawal of the rejection and allowance of the subject claim are earnestly solicited.

Claims 26-28 and 31-32

Dependent claims 26-28, and 31-32 incorporate all of the elements and limitations of independent claim 25, and, for at least the reason that Miller, Crisan, and Liu, separately and in combination, do not disclose, teach or suggest all of the elements of independent claim 25, dependent claims 26-28, and 31-32 are patentably distinguishable over the references. Accordingly, withdrawal of the rejections and allowance of the subject claims are earnestly solicited.

III. Claim 33 is rejected under 35 U.S.C. §103(a) as being unpatentable over MacHASP in view of Liu and Ban, and further in view of Evidence I: USB Special- The Key to Software and Security by Aladdin Knowledge System published September 1998 (hereinafter "Evidence I"). Applicant respectfully traverses this rejection for at least the reasons given below.

The Examiner cites Ban and Evidence I as allegedly disclosing certain structural details not shown in MacHASP and Liu, but both Ban and Evidence I fail to overcome the deficiencies of MacHASP and Liu. For example, MacHASP, Ban, Evidence I, and Liu, separately and in combination, fail to disclose, teach or suggest "a retractable cover having a rectangular cross-section to protect the USB connector from damage when the portable memory device is not connected to the USB-supporting data processing system," as recited in independent claim 33. Thus, for at least the same reasons that MacHASP, Ban, and Liu fail to disclose all of the elements recited in independent claim 33, per the discussion of the similar rejection of independent claim 1, and for the reason that Evidence I does not disclose, teach or suggest the elements not shown by the other references cited, the combination of references cannot make obvious the subject claim. Accordingly, withdrawal of the rejection and allowance of independent claim 33 are earnestly solicited.

IV. Claims 34-40 are rejected under 35 U.S.C. §103(a) as being unpatentable over MacHASP in view of Liu, Ban, Evidence I, and further in view of U.S. Patent No. 5,599,196 to Powell, et al. (hereinafter "Powell"). Applicant respectfully traverses these rejections for at least the reasons discussed below.

Dependent claims 34-40 incorporate all of the elements and limitations of independent claim 33. For at least the reasons discussed with regard to claim 1 regarding power connectors being non-analogous, Powell does not relieve the deficiencies of MacHASP, Liu, Ban and Evidence I. Thus, for at least the reason that MacHASP, Ban, Liu, Evidence I, and Powell, separately and in combination, do not disclose, teach or suggest all of the elements of independent claim 33, dependent claims 34-40 are patentably distinguishable over the references. Accordingly, withdrawal of the rejections and allowance of the subject claims are earnestly solicited.

V. Claim 33 is alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,671,808 to Abbott, et al. (hereinafter "Abbott") in view of Liu.

The Examiner cites Abbott as allegedly disclosing a portable USB memory device, but admits that Abbott does not teach an automatically retractable cover as recited in claim 33, the disclosure for which the Examiner relies on Liu. However, Liu cannot be properly applied to Abbott for at least the same reasons that Liu cannot be properly applied to MacHASP, as discussed above with regard to claim 1. Therefore, Abbott and Liu, separately and combined, do not disclose, teach or suggest the recitations of independent claim 33 and, for at least this reason, cannot make obvious this claim. Accordingly, withdrawal of this rejection and allowance of independent claim 33 are earnestly solicited.

VI. Claims 34-40 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Abbott in view of Liu and further in view of Powell.

Dependent claims 34-40 incorporate all of the elements and limitations of independent claim 33. Powell does not relieve the deficiencies of Abbott and Liu and, for at least the reason that Abbott, Liu, and Powell, separately and in combination, do not disclose, teach or suggest all of the elements of independent claim 33, dependent claims 34-40 are patentably distinguishable over the references. Accordingly, withdrawal of the rejections and allowance of the subject claims are earnestly solicited.

Double Patenting

Applicant acknowledges that claims 1, 24, 33-42 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting (ODP) as being unpatentable over claims

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21, 26-28, 47-49, 51-56 of the copending Application No. 11/410,105 and defers filing a terminal disclaimer until all other substantive matters have been resolved in this case.

New Claims

Claims 43-46 have been added. No new matter is being introduced and support for the added claims can be found throughout the subject patent application, such as, for example, FIGS. 2A-2C, 4A-4B, 6, and 7, the descriptions thereof, and the second paragraph under the heading DESCRIPTION OF THE PREFERRED EMBODIMENT.

Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 502827.

Respectfully submitted,

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